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10/731,173	12/08/2003	Shawn W. O'Driscoll	ACM 340US	5061
23581	7590	07/02/2007		
KOLISCH HARTWELL, P.C. 200 PACIFIC BUILDING 520 SW YAMHILL STREET PORTLAND, OR 97204			EXAMINER STOKES, CANDICE CAPRI	
			ART UNIT 3732	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.



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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/731,173
Filing Date: December 08, 2003
Appellant(s): O'DRISCOLL ET AL.

MAILED

JUL 02 2007

GROUP 3700

James R. Abney
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 02/14/07 appealing from the Office action mailed 09/12/06.

Art Unit: 3732

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

6,592,578	HENNIGES et al	7-2003
6,623,486	WEAVER et al	9-2003
4,565,193	STRELI	1-1986

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1) Claims 3,12-14 and 31-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Henniges et al (USPN 6,592,578). Henniges et al teach a system and method for installing plates for general bone repair. Henniges et al disclose “it is an additional feature of the present invention to color code the plates 10 for easy identification during a surgical procedure. The plates 10 can come in several different sizes and shapes depending on the specific application. By manufacturing the plates 10 with a unique color associated with each unique shape and size, confusion will be minimized and time will be saved. The color-coding will allow a doctor or nurse to identify and request the specific plate 10 and to better locate and implant screws and plates in vivo” (col. 6, lines 45-55). As to the portion of claim 34, “being configured to be secured...”, it is noted that it has been held that a recitation that an element is “configured to” perform a function is not a positive limitation and only requires the ability to so perform. It does not constitute a limitation in any patentable sense. Furthermore, with regard to the arguments about the functional language, it is noted that the law of anticipation does not require that the reference “teach” what the application teaches, but rather it is only that the claims under attack

Art Unit: 3732

“read on” something in the reference. *Kalman v. Kimberly Clark Corp.*, 218 USPQ 781 (CCPA 1983). In addition, the manner in which a device is intended to be employed does not differentiate the claimed apparatus from the prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987). As to Claim 12, plates 10 include a curve bone-facing surface configured to match the curved contour of the distinct bone region to which each plate is configured to be secured. Regarding Claim 13, the only difference between invention claimed in claim 34 and claim 13 is the printed matter, which in no way depends on the set, and the set does not depend on the printed matter. Therefore, the same rejection applied to claim 34 may also be applied to claim 13. As to Claims 31 and 32, the term “configured” merely requires the plates be capable of being secured to either corresponding or non-corresponding bones. Therefore, these limitations are met by the Henniges et al reference as well.

Henniges et al teach the claimed invention except for the distinct color indicating a left or right half of the skeleton. However, the Henniges et al reference does teach that the association of color with each plate makes it easier to identify and locate in the body. It would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate a color coded method for identifying the each plate as taught by Henniges et al in order to minimize confusion during a surgical procedure.

Regarding Claim 33, it would have been an obvious matter of design choice to manufacture the bone plates in any color, since applicant has not disclosed that having the plates blue and green solves any stated problem or is for any particular purpose and it appears that the invention would perform equally well with any color.

Art Unit: 3732

To claim 35, it would have been an obvious matter of design choice to make the pair of bone plates with a shape having corresponding mirror images of one another or any shape, since such a modification would have involved a mere change in the shape of a component. A change in shape is generally recognized as being within the level of ordinary skill in the art.

2) Claims 9 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Henniges et al in view of Streli (USPN 4,565,193). Henniges et al discloses the claimed invention except for one of the distinct bone region including one of the humerus bone and the proximal region and at least one of the bone plates includes at least one prong. Streli teaches a pronged plate “for use on the right or left half of the body”. Streli further teaches “using the pronged plate 1 in the region of the lower arm, the ulna and the radius” (col. 3, lines 40-41). It would have been obvious to one having ordinary skills in the art to incorporate the pronged plate used on the ulna into as taught by Streli into the set disclosed by Henniges et al in order to provide a means for better securing the plate the bone to better promote healing.

3) Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Henniges et al in view of Weaver et al (USPN 6,623,486). Henniges et al disclose the claimed invention except for the bone plate have a first portion configured to be secured adjacent an end of a long bone and a second portion configured to be secured toward or one the shaft of the long bone and wherein the first portion is thinner than the second portion. Weaver et al shows in Fig. 8 that the first portion is generally thinner that the second portion of the plate. It would have been obvious to one having ordinary skill in the art at the time of the invention to incorporate the thinner first portion of the bone plate as taught by Weaver et al into the invention disclosed by Henniges et al

Art Unit: 3732

in order to provide a bone plate which is better contoured to fit specific regions of bone and is better secured to the bone.

(10) Response to Argument

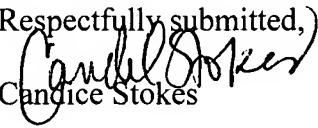
The Examiner maintains that the present invention is unpatentable over the Henniges reference because the Henniges reference teaches that color-coding bone plates for the purpose of identification. Specific colors used and specific uses of the identification as provided in the present amendment, do not render the claims patentable over the prior art of record. Henniges teaches a set of bone plates having different shapes and at least a pair of the bone plates being capable of being secured to the same left or right half of the skeleton and including the same color. However, Henniges also teaches "by manufacturing the plates 10 with a unique color associated with each unique shape and size, confusion will be minimized and time will be saved" (col. 6, lines 49-51). Therefore, at least a two-color system is provided.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.


For the above reasons, it is believed that the rejections should be sustained.


Respectfully submitted,


Candice Stokes

Conferees:

Cris Rodriguez; Thomas Barrett


TQAS 3700


SPE 3732